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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,173	11/19/2003	Jeffrey L. Anderson	CM-006C (Div.)-US	9325
7590	06/25/2004		EXAMINER	
Neil E. Hamilton 8310 16th Street, M/S 509 P.O. Box 902 Sturtevant, WI 53177-0902			SELLERS, ROBERT E	
			ART UNIT	PAPER NUMBER
			1712	
			DATE MAILED: 06/25/2004	

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/718,173	Applicant(s) ANDERSON ET AL.
	Examiner Robert Sellers	Art Unit 1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.  
 If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.  
 If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.  
 Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on \_\_\_\_.  
 2a) This action is **FINAL**.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 2,3,10,12,13,21,33,34 and 41-54 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_ is/are allowed.  
 6) Claim(s) \_\_\_\_ is/are rejected.  
 7) Claim(s) \_\_\_\_ is/are objected to.  
 8) Claim(s) 2,3,10,12,13,21,33,34 and 41-54 are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) <input type="checkbox"/> Notice of References Cited (PTO-892) 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>11/19/2003</u> .	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date ____. 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) 6) <input type="checkbox"/> Other: _____
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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 42-50, drawn to a method of preparing an acrylic-epoxy powder coating comprising mixing the reaction product of a *reactive functional groups-containing addition polymer A* and a *co-reactive functional groups-containing polymer B* with an *epoxy resin* and an *acrylic resin*, classified in class 525, subclass 108.
  - II. Claims 2, 3, 10, 33, 34, 41, 52 and 54, drawn to a composition comprising the reaction product of a *reactive functional groups-containing addition polymer A* and a *co-reactive functional groups-containing polymer B*, classified in class 525, subclass 176.
  - III. Claims 12, 13, 21 and 53, drawn to a process for preparing a composition comprising reacting a *reactive functional groups-containing addition polymer A* and a *co-reactive functional groups-containing polymer B*, classified in class 525, subclass 183.

The inventions are distinct from each other because:

2. Inventions II and I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product as claimed can be used in a materially different process of using that product such as a method of fabricating a molded object.

3. Inventions III and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the process of reacting mutually reactive polymers as claimed can be used to make another materially different product such as the non-gelled reaction product of an epoxy resin and a polyetherpolyamine.

4. The method of preparation of Invention I involves a materially different addition mixing step of already reacted A and B polymers with an epoxy resin and acrylic resin which is distinct from only the reaction of the A and B polymers of Invention II.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. This application contains claims directed to the following patentably distinct species of the claimed invention:

i) The A polymers such as the styrene/acrylic acid/ $\alpha$ -methylstyrene copolymer of claim 49 if Invention I is elected, or the styrene/2-ethylhexyl acrylate/2-hydroxyethyl methacrylate copolymer of claim 10 or 41 (contingent upon the election of Invention II) or claim 21 (contingent upon the election of Invention III).

ii) The B polymers wherein a single species is designated from those denoted in claim 46 and co-reactive functional groups are identified from claim 47 (Invention I), 52 or 54 (Invention II), or claim 53 (Invention III).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species within each of items i) and ii) hereinabove for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 2, 3, 10, 12, 13, 21, 33, 34 and 41-54 are generic.

A reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species (MPEP § 809.02(a)).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

6. The reply to this requirement to be complete must include an election of the invention and species to be examined even though the requirement be traversed (37 CFR 1.143). Upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

7. The Information Disclosure Statement filed November 19, 2003 has been considered and initialed since it contains the same references recited in parent application no. 09/930,912. However, the Information Disclosure Statement filed February 24, 2004 contains new citations and will not be considered until the election of an invention and species is filed.

8. The specification on page 1, paragraph [0001] according to the preliminary amendment filed November 19, 2003 should include the U.S. Patent No. of 6,696,522 for parent application no. 09/930,912.

(571) 272-1093 (Fax no. (703) 872-9306)  
Monday to Friday from 9:30 to 6:00 EST

Any administrative inquiries can be obtained by accessing the Patent Application Information Retrieval (PAIR) system. Published applications are available through either private or public PAIR. Unpublished applications are available via private PAIR only. Consult <http://pair-direct.uspto.gov> or contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

rs 6/24/04



ROBERT E.L. SELLERS  
PRIMARY EXAMINER